

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 4778**
Claudio ZAMPIERI : Attorney Docket No. 2005_1196A
Serial No. 10/549,857 : Group Art Unit 3618
Filed September 23, 2005 : Examiner Cynthia F. Collado
IN-LINE ROLLER-SKATE FOR RACING : **Mail Stop: AMENDMENT**
(AS AMENDED)

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of April 23, 2008, Applicant in the above application kindly requests reconsideration of the rejections contained therein.

The Office Action

On page 2 of the Office Action, the Examiner indicated that the Affidavit under 37 CFR 1.132 that was filed on January 30, 2008 is sufficient to overcome the rejection of claim 5 based upon the 100 mm big wheel concept. The Examiner is thanked for this indication.

However, the Examiner then goes on to reject claims 5 and 7 as being unpatentable over Borel, which is the reference previously cited and identified as U.S. Patent Application Publication No. 2001/0013695, now in view of Hilgarth, U.S. Patent 6,015,157. In particular, the Examiner alleges that Borel discloses the claimed center to center distance between the first and second binding points of claim 5, but acknowledges that Borel lacks a teaching of at least four wheels having a diameter of at least 100 mm.

Hilgarth is cited for larger diameter wheels. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Borel to include wheels with a 100 mm diameter to allow the user to maintain substantially optimum skating conditions. This would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention, according to the Examiner.

However, it is respectfully submitted and believed that the Declarations that were previously submitted refute this position of the Examiner, that it would not have been obvious to combine Hilgarth with Borel and that a *prima facie* case of obviousness is not established by the references cited by the Examiner, particularly in view of all of the evidence that is of record.

Interview

The Examiner is thanked for her courtesy in granting and conducting the interview of September 12, 2008 in the above application. During the interview, the teachings of the respective references, as well as the evidence that has been established by the previously submitted Declarations, were discussed. While no agreement was reached in the interview, the following discussion is based upon the discussions during the interview, and responsive to the concerns of the Examiners. It is further noted that the Examiners acknowledge that more detailed treatment of the Declarations under 37 CFR 1.132 in this application, beyond acknowledging the Declarations and indicating that they overcame the previous rejections, should have been made, particularly with respect to the evidence presented therein and the weight being accorded by the Examiners. This will also be discussed further below.

The Borel Application

As discussed during the interview, Borel includes no indication of the wheel size of the skate of Borel. However, as has also been previously discussed, Borel is directed to an aggressive type of skate. Such types of skates are not required to be fast, but they do need to be highly maneuverable and very close to the ground. They are provided with wheels that have a

diameter smaller than conventional wheels, and certainly not as large as claimed in claim 5. The actual Vinny Minton model that is marketed has a wheel size of about 55 mm in diameter; note section 10 of the Declaration of Mr. De Lazzari. The center to center distance between the first and second binding points of the actual skate is approximately 167 mm. It is in fact against the knowledge of one of ordinary skill in the art to increase the size of the Borel wheel; see section 11 of the Declaration of Mr. De Lazzari.

When combining references, it is improper to combine references where the references teach away from their combination. See MPEP §2146(X)(D). A proposed modification should not render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. Thus, it cannot be considered obvious to enlarge the wheels of Borel to 100 mm, as this destroys the fundamental point of the Borel skate in being an aggressive skate. Borel does acknowledge that the wheels 18 could have a slightly larger diameter, but emphasis must be made upon the term "slightly." A change to a wheel of a size of 100 mm changes the character and operating principle of the Borel skate, which is not obvious.

In the Office Action, the Examiner cites Borel as having a center to center distance between the first and second binding points of 170 mm and 210 mm, noting, column 3, paragraph 45. However, paragraph 45 of page 3 of the Borel publication in fact discusses the length of the overall frame as being between 230 mm and 280 mm, or boots having a size from 240 mm to 310 mm. It does not support the statement that the Examiner is making.

In the background of the invention there is a general discussion of how to fix a boot to a skate frame. The discussion is not limited to the aggressive type of skate of Borel, but provides a general discussion that for the same model of skate in various sizes, the distance that separates two fixing points varies from about 140 mm to 210 mm. However, as noted in the Summary of the Invention beginning in paragraph 15, for example, the skate of Borel is actually directed to a center to center distance between 164 mm and 170 mm, and more particularly about 167 mm. As also noted from the Declarations, this is confirmed from looking at the actual skate model that is sold that corresponds to this patent application.

In any case, the fundamental point that needs to be made here is that what is claimed is a combination of features, including the at least four wheels being solely wheels having a diameter of at least 100 mm and the center to center distance between the first and second binding points being between 170 mm and 210 mm. The Examiner cited Hilgarth for the proposition of it being obvious to provide wheels of 100 mm in diameter, at least.

The Patent to Hilgarth

As was noted by the Examiners during the interview, Hilgarth discusses, at the beginning of Hilgarth's specification, roller skates in general. There are statements in the second paragraph in column 1 that the terms roller skate and skate with aligned wheels are understood in the widest sense of the words and include all kinds of embodiments of footwear suitable for skating or sliding on any kind of surface. The context thus includes roller skates which have their wheels arranged transversely and roller skates which have their wheels aligned and other particular types of skates.

However, as was also noted by Applicant during the interview, Hilgarth is particularly directed to problems associated with skating on off-road tracks, shock absorption, the skater's stability and support for the skater's ankle. The general concern that would be clear to one of ordinary skill in the art from Hilgarth are problems associated with irregularities of a track or off-road tracks. It is this type of skate, clearly, that Hilgarth is directed to.

Thus, Hilgarth is directed to an off-road type of skate that has a relatively high profile. This type of skate is not good for racing. Further, this type of skate does not necessarily provide any teaching that would be applicable to an aggressive type of skate as in Borel.

As stated in column 4 of Hilgarth, the skating elements have a diameter of between 90 and 120 mm, and advantageously between 100 and 110 mm. But the arrangement of Hilgarth is one in which there is an articulated type of connection between the shoe and the support at a desired point. As can be seen from the drawings, not all of the wheels are in the same plane in order to allow for dealing with track irregularities. Shock absorbing features are added. Clearly, Hilgarth is directed to a very different type of skate from either Borel or the present invention.

It is respectfully submitted that one of ordinary skill in the art would not have considered modifying the wheels of Borel from Hilgarth. While Hilgarth teaches wheels from 90 to 120 mm, it does so for its own particular type of skate. As has been established by the evidence contained in the Declarations, which evidence has not been refuted by the Examiner, an aggressive type of skate as taught by Borel desires a smaller wheel, on the order of 55 mm size. It is not obvious to substantially increase this size.

The Combination of Borel of Hilgarth is not Obvious

The Examiner takes the position that, based on the teaching of Hilgarth, it would have been obvious to have wheels with 100 mm in diameter "to allow the user to maintain substantially optimum skating conditions." However, as has been previously established by the Declaration of Mr. De Lazzari in section 11, Borel is directed to an aggressive skate; to one of ordinary skill in the art, an increase in size to 100 mm in diameter is not obvious, but is instead undesirable. In fact, the optimum size for wheels of the type disclosed by Borel is in fact about 55 mm according to the evidence of record.

Accordingly, the evidence of record establishes, without being refuted by any evidence pointed to by the Examiner, that an increase in size of the wheels of Borel to 100 mm in diameter is not obvious and against the teachings of the prior art. Optimum skating conditions would not result if such a change were made. There is no support in the evidence of record for the statement made by the Examiner.

The Examiner further makes the statement that the claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. This statement by the Examiner is also not supported by the evidence of record, and is in fact refuted by the evidence of record.

As has been previously discussed, independent claim 5 represents a combination of features, including the center to center distance and the size limitation of the wheels. The evidence of record indicates that this combination yields better and non-obvious results than would have been predicted by the prior art.

The Declaration of Mr. De Lazzari states, in section 11, that the two features of the center to center distance and the wheel size limitation work together to allow for larger sized wheel without employing a compromise solution. The prior art did not in fact recognize that the distance between the first and second binding points could be changed in combination with the change in wheel size so as to arrive at the elegant solution to the problem that is described in the present specification. This evidence is not refuted by any other evidence of record.

The Declaration of Mr. Prandina establishes in section 3 that year after year consumers have recognized the benefit of the present invention from a performance and comfort point of view with constantly growing sales. The superiority of the combination as set forth in claim 5 is established in section 4 of the Declaration of Mr. Prandina, presenting evidence that the present invention provided great success in winning almost all of the races in which the claimed combination was used. The same section provides unrefuted evidence of copying by competitors. Section 5 of the Declaration of Mr. Prandina establishes that a combination of features according to claim 5 results in better maneuverability and faster speed; see also Exhibit M attached to this Declaration.

As discussed in Exhibit M, moving the boot/frame connection to 195 mm, for example, makes it possible to maintain the same ground clearance as with a 5 x 84 mm set up as well as to fix the wheels of the same distance with respect to one another. With 165 mm boot/frame connection between the first and second wheels there would be more space. But it has been demonstrated that this results in a speed reduction in curves. A low balance solution according to the present invention provides greater stability and increased control and sensitivity. Statistical reports of the FIHP demonstrate that the 4 x 100 mm set up provides 4% additional speed as compared with the previous 5 x 84 mm set up. This evidence also stands as unrefuted by the Examiner.

Section 6 of the Declaration of Mr. Prandina establishes that skating federations were forced to change their rules to allow for the 4 x 100 mm set up according to the present invention in view of the great success of the set up and the desire by competitors to use this set up. This evidence also stands as unrefuted by the Examiner.

The Examiners, during the interview, pointed to the recent decision in KSR. However, it must be noted that KSR still requires that there be a rationale that is recognized by one of ordinary skill in the art to make a combination rejection. Essentially, in KSR the decision simply said that there is not a strict requirement for a teaching or motivation to combine be found in the explicit terms of the prior art to make a rejection. But the court took pains to emphasize that there must still be a reason that would be recognized by one of ordinary skill in the art for a combination to be made.

The evidence of record in this application does not in fact support the Examiner's combination. The evidence of record, in particular the Declarations of Mr. De Lazzari and Mr. Prandina, makes it clear that the combination is not obvious.

Any Further Action Should be Non-Final

In the Office Action, the Examiner withdrew the previous rejection based upon the Declarations, but went on to make a new rejection despite the presence of such Declarations. However, as has been noted above, the evidence of such Declarations are as equally applicable with the current rejection. These Declarations, which stand unrefuted by the Examiner, clearly establish that the modification that the Examiner proposes to make to Borel would not in fact have been obvious to one of ordinary skill in the art. The Declarations provide evidence to this effect, and there is no evidence contradicting the evidence of these Declarations. Thus, the balance of the evidence of record clearly points to non-obviousness.

This type of evidence, further, must be considered by the Examiner. Further, the Declarations should be commented upon by the Examiner in the action succeeding the submission of the Declarations. As noted in MPEP §716.01, if the Examiner takes the position that the evidence is sufficient to overcome the *prima facie* rejection, comments should be consistent with the types of comments provided in statements of reasons for allowance. In this situation, however, the Examiner withdrew the previous rejection, but made a new rejection. As has been thoroughly explained above, the Declarations are as equally applicable to the new rejection as to the prior rejection. Thus, if the Examiner is deeming that the Declarations are

insufficient to overcome this newly presented rejection, the Examiner should specifically explain why the evidence is insufficient.

It is submitted and believed that the evidence that is of record in this application clearly refutes the positions taken by the Examiner for the obviousness of claim 5 and claim 7. If the Examiner persists in the rejection, then the Examiner is respectfully requested specifically point out how the Declarations, in the view of the Examiner, are not entitled to be considered for the evidence that they present. As this has not been done at this point in time, any such further action should of course be made non-final.

Conclusion

The evidence of record clearly establishes that the present invention as reflected by independent claim 5 and dependent claim 7 is not obvious from the prior art cited by the Examiner. The combination and modification that the Examiner proposes is against the understanding of one of ordinary skill in the art, and there is no reason for one of ordinary skill in the art to make such a combination when all of the evidence of record is properly considered. Accordingly, the Examiner is respectfully requested to withdraw the rejection and allow claims 5 and 7.

In view of the above remarks, it is submitted that the present application is now in condition for allowance, and the Examiner is requested to pass the case to issue. If the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact Applicant's undersigned representative.

Respectfully submitted,

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September 23, 2008